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EXAMINER

COONEY, JOHN M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Applicant's arguments filed 2-27-09 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grace et al.(4,892,893) in view of WO 03/078497.

Grace et al. discloses preparations of flexible polyurethane foams by mixing and reacting polyether polyol having functionalities and molecular weights as claimed and isocyanates at Index values within the ranges of values claimed, melamine and blowing agent, phosphorus containing fire retardants as claimed by applicants, catalysts, and stabilizers in amounts within the ranges of values claimed (see column 2 line 22 - column 7 line 48 and the examples, as well as, the entire document).

Grace et al. differs from applicants' claims in that it does not specifically require its melamine to have the size and amount specifications as claimed by applicants. However, Grace et al. does recite control of its melamine particle sizes and amounts for the purpose of maintaining system stability and satisfactory product formation (see column 6 line 39 - column 7 line 32). Accordingly, it would have been obvious for one having ordinary skill in the art to have varied the amounts and sizes of the melamine particles employed within the teachings of Grace et al. for the purpose of maintaining

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system stability and satisfactory product formation within the preparations of Grace et al. in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Also, regarding variations in amounts and sizes of this component, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of the same properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Grace et al. differs from applicants' claims in that it does not specifically require the use of the silicone stabilizers defined by applicants' claims. However, Grace et al. does recite the need for these silicon assistant materials for their foam structure stabilizing effect and WO-'497 discloses the particular use of stabilizers of applicants' invention, such as Silicone L-620 (see page 19, Table 11, as well as, the entire document), for the purpose of making acceptable melamine particle containing flexible polyurethane foams. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the stabilizers of WO-'497 as the silicone foam stabilizing component employed in the preparations of Grace et al. for the purpose of providing their foam structure stabilizing effect in the preparations of Grace et al. in

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order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicant's arguments have been considered. However, rejection is maintained.

Applicants' amendment to the phosphorus features of their claims are unpersuasive in distinguishing applicants' claims in that Grace et al.'s disclosure specifically identifies phosphorus fire retardants meeting the criteria of applicants' claims(column 7 lines 33-48).

It is maintained that the particle size limitations are adequately addressed by the grounds of rejection set forth above, and position is maintained to be proper. Patentable distinction has not been established in the evidence of record.

It is maintained that the secondary WO-'497 does adequately address the deficiencies of the primary reference, and rejection based on the combinations of the cited prior art is proper.

As to applicants' showings of results, the following must be considered:

Results Must be Unexpected:

Unexpected properties must be more significant than expected properties to rebut a prima facie case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

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In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

Claims Must be Commensurate With Showings:

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to overcome a reasonable case of prima facie obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Applicants' have not persuasively demonstrated unexpected results for the combinations of their claims. Applicants have not clearly demonstrated their results to be unexpected and more than mere optimizations of the knowledge in the art or more significant than being secondary in nature. Applicants' have not demonstrated their showing to be commensurate in scope with the scope of combinations now claimed.

The evidence of applicants' declaration has been considered. However, it and all of the current evidence of record are insufficient in demonstrating evidence of unexpected results that are commensurate in scope with the scope of materials encompassed by the claims as they currently stand. Though the results of the affidavit

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offer a showing of unexpected results for a specific composition of materials from within the scope of their claims, this showing is not sufficient in demonstrating new or unexpected results for the ranges of reactants, additives, amounts and sizes encompassed by the scope of applicants' claims as they currently stand.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidieck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/
Primary Examiner, Art Unit 1796